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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applied for Mark	IPOD
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Date	05/15/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: Apple Inc.

Serial No: 78/521,891

Filed: Nov. 23, 2004

Mark: **IPOD**

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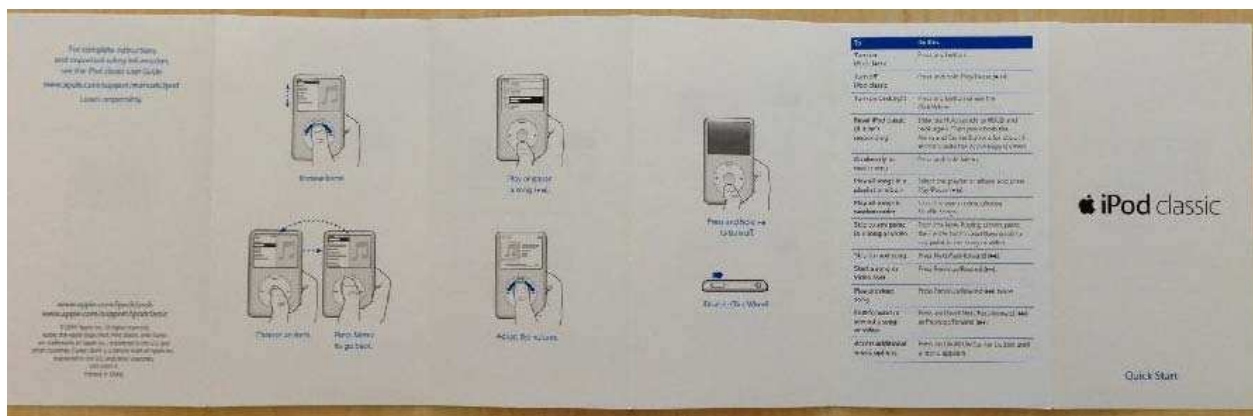
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# INTRODUCTION

Applicant Apple Inc. seeks to register its famous mark IPOD for “printed materials and publications, namely, brochures, pamphlets, and leaflets, all relating to computer software, computer hardware, and multimedia apparatus and instruments and sold or distributed in connection with handheld mobile digital media devices” in Class 16. Apple submitted in connection with its Statement of Use, dated July 12, 2013, a specimen comprised of a photograph of its IPOD Quick Start Guide, depicted below (the “Original Specimen”).<sup>1</sup>



Apple later, in its July 18, 2014 Office Action Response, submitted the following excerpts from the reverse side of the IPOD Quick Start Guide to further inform the Examining Attorney of its contents<sup>2</sup>:

<sup>1</sup> See Apple's Statement of Use dated July 12, 2013.

<sup>2</sup> See Apple's July 18, 2014 Response to Office Action at \*4-\*6, Ex. 2 ("Apple's Second Response").



Download and install iTunes:  
[www.apple.com/ipod/start](http://www.apple.com/ipod/start)

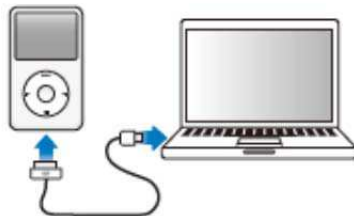
View the user guide:  
[www.apple.com/support/manuals/ipod](http://www.apple.com/support/manuals/ipod)



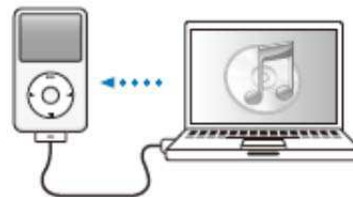
Get music and more at the iTunes Store.



Also import music from CDs.



Connect to USB port on computer  
(not keyboard) to set up and  
begin charging.



Sync content while the battery charges.



Follow onscreen instructions  
(may take a few minutes to appear  
when iPod classic is charging).

Charging      Charged



Charge fully or at least 4 hours,  
while computer is awake.

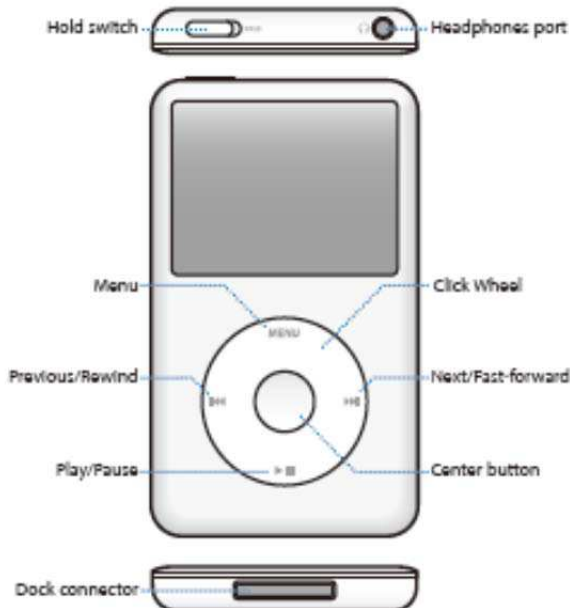


To disconnect after syncing, click Eject (▲).



Then remove the cable.

## iPod classic



To	Do this
Turn on iPod classic	Press any button.
Turn off iPod classic	Press and hold Play/Pause (▶  ).
Turn on backlight	Press any button or use the Click Wheel.
Reset iPod classic (if it isn't responding)	Slide the Hold switch to HOLD and back again. Then press both the Menu and Center buttons for about 6 seconds, until the Apple logo appears.
Go directly to main menu	Press and hold Menu.
Play all songs in a playlist or album	Select the playlist or album and press Play/Pause (▶  ).
Play all songs in random order	From the main menu, choose Shuffle Songs.
Skip to any point in a song or video	From the Now Playing screen, press the Center button and then scroll to any point in the song or video.
Skip to next song	Press Next/Fast-forward (▶▶).
Start a song or video over	Press Previous/Rewind (◀◀).
Play previous song	Press Previous/Rewind (◀◀) twice.
Fast-forward or rewind a song or video	Press and hold Next/Fast-forward (▶▶) or Previous/Rewind (◀◀).
Access additional music options	Press and hold the Center button until a menu appears.

Additionally with its July 18, 2014 Office Action Response, Apple submitted substitute specimens consisting of third-party printed publications from Sony and Yamaha (the “Substitute Specimens”) both bearing Apple’s IPOD mark in the composite Made for iPod Logo, depicted below.<sup>3</sup> Apple subsequently established that such usage was pursuant to a license and therefore is use that inures to Apple’s benefit.<sup>4</sup>



Notwithstanding the foregoing, the Examining Attorney erroneously refused and maintained refusals against the Original Specimen and Substitute Specimens on the basis that they do not constitute “goods in trade,” and, with respect to the Substitute Specimens, that they only show use of the mark for compatibility information, and not source indicating trademark usage. For the reasons outlined below, Apple submits that both refusals are erroneous and should be withdrawn, that the Original Specimen and Substitute Specimens should be deemed valid specimens of use for the goods, and that the application should be approved for registration.

**I. APPLE’S IPOD QUICK START GUIDE AND SUBSTITUTE SPECIMENS ARE ALL VALID “GOODS IN TRADE”**

Apple’s specimens are valid “goods in trade.” They meet the statutory requirements of the Lanham Act and are analogous to countless printed manuals and publications regularly provided by the technology trade, and widely accepted by the PTO, as an acceptable specimen format for the Class 16 goods identified in the Application. Furthermore, the authorities cited by the Examining Attorney do not prohibit the acceptance of Apple’s specimens. The present

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<sup>3</sup> See Apple’s Second Response at \*11, Substitute Specimens.

<sup>4</sup> See Apple’s February 19, 2015 Request for Reconsideration, Exs. 4, 5 (“Apple’s Request for Reconsideration”).



appeal is the result of the Examining Attorney's inaccurate restatement of the Federal Circuit and Board's prevailing "goods in trade" test, which the Examining Attorney has independently refashioned to suit examination of the goods at hand, which are vastly different than the goods meant to be examined under such test. If the Examining Attorney's newly fashioned test is adopted by the Board, it could call into question the validity of numerous trademark registrations which issued based on similar specimens and usages. Perhaps appreciating the potential consequences of this newly fashioned test, and to prevent the potential fallout to third parties in Apple's trade, the Examining Attorney draws meaningless and unconvincing distinctions between Apple's specimens and analogous publication specimens previously provided by the technology trade and accepted by the PTO.

A. According to the statutory language of the Lanham Act, Apple's Specimens are valid "goods in trade."

The statutory language of the Lanham Act compels the finding that Apple's IPOD Quick Start Guide and Substitute Specimens (collectively, "Apple's Specimens") are all valid "goods in trade." Lanham Act § 45, 15 U.S.C. § 1127, defines "use in commerce" as "the bona fide use of a mark in the ordinary course of trade." Under the Lanham Act, a mark is considered to be in use in commerce on goods when (1) it is placed in any manner on the goods, and (2) the goods are transported in commerce. *Id.* While a formal sale is not always necessary, items sold or transported in commerce are not "goods in trade" unless they have utility to others as the type of product named in the trademark application. T.M.E.P. § 1202.06(a). Apple's Specimens depict the IPOD mark affixed to the brochures, leaflets and pamphlets recited in the Application, and Apple's Specimens are transported in commerce. Apple's Specimens have utility to consumers as the type of product named in the trademark application, i.e. brochures, leaflets and pamphlets relating to computer goods and which are sold or distributed in connection with handheld mobile

digital media devices. Apple is therefore making valid trademark use of IPOD that comports with the Lanham Act.

- B. The technology trade distributes printed publications with its technology goods, often in the same box and often under the same mark, and the USPTO widely accepts Class 16 specimens depicting such use.

The Examining Attorney disregards that the computing and technology trade regularly distributes, and the PTO widely accepts as suitable trademark specimens, printed publications analogous to Apple's Specimens. The trade regularly identifies these publications as either "pamphlets," "informational brochures," "data sheets," "user guides," "product information guides," "maintenance manuals," "quick guides," "getting started guides," "instruction manuals," and similar designations. These publications are also regularly included in the box that transports the computing goods. Apple has submitted numerous examples of such third party registrations, and the underlying brochures accepted as specimens in the course of prosecution of this application.<sup>5</sup> Some of the specimens of manuals the PTO has accepted as demonstrating valid trademark use for Class 16 goods consist of just the front and back cover of a manual or a simple tri-fold brochure about a company's consumer electronic goods offered under the same mark.<sup>6</sup> Comparatively, Apple's Specimens depict more detailed information than many of the third-party specimens previously accepted by the PTO.

Against this backdrop, Apple's Specimens are fairly uncontroversial; nonetheless, the Examining Attorney has steadfastly rejected Apple's Specimens.

- C. The "goods in trade" authorities do not prohibit the acceptance of Apple's Specimens.

Federal Circuit and Board authorities addressing whether specimens are "goods in trade," including those cited in the Examiner's Office Actions, do not prohibit the acceptance of Apple's

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<sup>5</sup> See Apple's December 23, 2013 Response to Office Action at \*4, Exs. A, B, and E ("Apple's First Response"); see also Apple's Request for Reconsideration, Ex. 3.

<sup>6</sup> See Apple's Request for Reconsideration, Ex. 3.

Specimens. According to “goods in trade” decisions, registration should be refused to principally four different kinds of specimens: packaging,<sup>7</sup> advertising material,<sup>8</sup> conduits for the rendering of a service,<sup>9</sup> and incidental items that an applicant uses to conduct its business (e.g., letterhead, invoices, and business forms).<sup>10</sup> Apple’s Specimens fall into none of these categories.

Apple’s Specimens cannot be considered packaging for the iPod device akin to the trapezoidal cardboard box design that was the subject of the specimen in *In re MGA Entm’t, Inc.*, 84 U.S.P.Q.2d 1743, 1747 (T.T.A.B. 2007). In *MGA*, the Board stated that “the mere fact that original boxes or packaging may be used to store products does not infuse such boxes or packaging with additional utility such that they constitute goods in trade.” *Id.* at 1746-47 (affirming the refusal to register). *MGA* clearly does not apply.

Similarly, Board authorities rejecting advertising material as a form of acceptable specimen for Class 16 goods do not apply to Apple’s Specimens. According to Merriam-Webster’s online dictionary ([www.m-w.com](http://www.m-w.com)), “advertising” is defined as “the action of calling something to the attention of the public especially by paid announcements” and an “advertisement” as “a public notice; especially: one published in the press or broadcast over the air.”<sup>11</sup> Apple’s Specimens can hardly be considered advertising for the iPod device since they are shipped in the same box as the iPod device itself (or, in the case of the Substitute Specimens, the boxes of third-party products) and are not published in the press or broadcast over the air.

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<sup>7</sup> *E.g., In re MGA Entm’t, Inc.*, 84 U.S.P.Q.2d 1743, 1747 (T.T.A.B. 2007) (holding packaging boxes for toys, games, and playthings not goods in trade where packaging boxes were not sold separately and had no independent value apart from applicant’s primary goods).

<sup>8</sup> *E.g., Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768 (T.T.A.B. 1994) (holding games not goods in trade where the games had no real function or entertainment value as games but functioned only as advertising flyers for applicant’s musical group).

<sup>9</sup> *E.g., In re Ameritox Ltd.*, 101 U.S.P.Q.2d 1081, 1084 (T.T.A.B. 2011) (holding reports featuring medical laboratory results not goods in trade where applicant solely provided drug testing services, and reports were not sold separately and had no independent value apart from applicant’s primary service).

<sup>10</sup> *See* T.M.E.P. § 1202.06.

<sup>11</sup> *See* Apple’s Second Response at \*10, Ex. 6.

Nor are Apple's Specimens conduits through which Apple provides its services. *See, e.g., Lens.com, Inc. v. 1-800-Contacts, Inc.*, 103 U.S.P.Q.2d 1672, 1676-77 (Fed. Cir. 2012) (holding computer software used for ordering contact lenses not goods in trade where applicant solely provided online retail stores for eyewear products, and software was not sold separately and had no independent value apart from applicant's primary retail service); *see also Thomas White Int'l, Ltd.*, 106 U.S.P.Q.2d 1158, 1161-62 (T.T.A.B. 2013) (holding that annual investment reports not goods in trade because they are the means through which applicant provides its investment services).

Lastly, Apple's Specimens are not incidental items that Apple uses to conduct its business (e.g., letterhead, invoices, and business forms). Apple's Specimens provide utility to Apple's customers and to independent service providers who require information about the iPod device in order to service the devices.<sup>12</sup>

D. The Examining Attorney has erringly fashioned a new test for determining whether an applicant's goods are "goods in trade".

The Examining Attorney has misapplied the "goods in trade" test laid out in *Lens.com Inc. v. 1-800 Contacts Inc.*, 103 U.S.P.Q.2d 1672 (Fed. Cir. 2012), by using it to evaluate vastly different goods than the goods at issue in that case. In *Lens.com*, the issue was whether Lens.com's ordering software is merely the conduit through which Lens.com renders its online retail services or whether the software is a valid "good in trade." *Id.* at 1676. According to the Federal Circuit, to determine whether goods are indeed "good in trade," the relevant factors to consider include whether the goods: (1) are simply the conduit or necessary tool useful only to obtain applicant's services; (2) are so inextricably tied to and associated with the service as to have no viable existence apart therefrom; and (3) are neither sold separately from nor has any

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<sup>12</sup> *See* Apple's Request for Reconsideration.

independent value apart from the services. *Id.* This test is used to determine whether a good is simply a conduit for a party's *services*, which does not apply to Apple's IPOD Quick Start Guide, as Apple's iPod device is not a service.

In applying the facts of the current application to this standard, the Examiner errs by eliminating prong (1) of the *Lens.com* test, i.e. whether the goods are simply the conduit or necessary tool useful only to obtain applicant's *services*, and attempts to fashion a new modified "goods in trade" test to Apple's IPOD Quick Start Guide, inquiring only whether:

- (1) The goods are so inextricably tied to and associated with applicant's principal goods, i.e., digital media devices, as to have no viable existence apart from them
- (2) The goods are sold separately from or have any independent value apart from applicant's digital media devices.

(First Office Action at \*2) (citing to *Thomas White Int'l, Ltd.*, 106 U.S.P.Q.2d at 1161-62) (citing to *Lens.com, Inc.*, 103 U.S.P.Q.2d 1672).<sup>13</sup> There is no basis for dropping this first prong in any legal authority that Apple can locate. The Examining Attorney cannot simply ignore the first prong of the test, as it informs examiners when to apply the test. The IPOD Quick Start Guide is not a "conduit" or "necessary tool useful only to obtain [Apple's] *services*," and therefore the *Lens.com/Thomas White* test is inapplicable to Apple's IPOD Quick Start Guide.

Reshaping the *Lens.com/Thomas White* test to the goods at hand in the manner in which the Examining Attorney has done could have significant harmful consequences to existing registrants' rights. If Apple's IPOD Quick Start Guide fails to qualify as an adequate specimen because, according to the Examining Attorney, (1) it is inextricably tied to and associated with Apple's iPod device that the publication has no viable existence apart from Apple's iPod device, and (2) Apple does not sell the IPOD Quick Start Guide separately from its device, this new test could make it very difficult, if not impossible, to obtain Class 16 registration for any manual or

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<sup>13</sup> See the Examining Attorney's August 19, 2014 Final Office Action at \*2 (the "Final Office Action"); *see also* the Examining Attorney's March 15, 2015 Reconsideration Letter at \*2 (the "Reconsideration Letter").

guide distributed in connection with a technology device. Permitting the Examiner's novel test to stand would disadvantage technology manufacturers and their customers by significantly limiting the ability to register and protect marks for informational and instructional publications sold with and explaining the operation of technology devices.

Moreover, a decision by the Board adopting the Examiner's proposed two-part test could imperil the validity of countless existing registrations in Class 16 obtained using specimens analogous to Apple's specimen in the present application. Such registrations include, without limitation, all the comparable registrations submitted by Apple in the course of prosecution in support of the present application.<sup>14</sup>

Nonetheless, even if the Board adopts the Examiner's two-part test, Apple's IPOD Quick Start Guide meets the strictures of such test since it is not so inextricably tied to Apple's iPod device as to have no viable separate existence, and although distributed with the iPod device, the guide does have independent value. Such value is evidenced by the numerous analogous quick guides for Apple's iPod device, as well as other parties' consumer electronic devices, that are sold independently from such devices submitted along with Apple's Request for Reconsideration.<sup>15</sup> The fact that analogous guides are in fact sold independently from such devices clearly demonstrates that such guides have value separate and apart from the devices and are therefore goods in trade. If such third party manuals and brochures are goods in trade, there is no reasoned distinction that would explain why Apple's IPOD Quick Start Guide should not also be considered a valid good in trade.

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<sup>14</sup> See Apple's First Response at \*4, Ex. B; *see also* Apple's Request for Reconsideration, Ex. 3.

<sup>15</sup> See Apple's Request for Reconsideration, Exs. 1, 2.

- E. The Examining Attorney has drawn artificial and untenable distinctions between Apple's IPOD Quick Start Guide and publication specimens that are widely accepted by the PTO.

Perhaps aware of the sweeping nature of the new two-step rule purportedly established in this case, the Examining Attorney attempts to draw artificial and untenable distinctions between Apple's Quick Start Guide and the printed publication specimens provided by other technology companies that the PTO has previously accepted as valid Class 16 specimens, as identified in Apple's papers and Exhibits.

The Examining Attorney's first argument is that third party owner's manuals can qualify as "goods in trade" because they provide "operation and maintenance information for digital media devices," but Apple's Quick Start Guide cannot so qualify because it contains only "basic" information such as powering Apple's devices on and off.<sup>16</sup> The complexity of instructions in a manual as a determinant for specimen validity is completely irrelevant and arbitrary, and unsupported by the Trademark Rules. Apple provided a full copy of the IPOD Quick Start Guide, shown above, which provides more than "basic" information about Apple's iPod devices, informing consumers that they may obtain digital media files from Apple's iTunes Store service, that they can import music from CDs, that they can use one's computer as a charging device for the iPod device, that they can sync content between one's iPod device and iTunes library, of the optimal charging times for the iPod device, how to disconnect the iPod device from one's computer, how to reset the iPod device, how to turn on the backlight of the iPod device, how to play all songs in a playlist or album, how to play songs at random, how to skip to any point of a song or video, and how to access additional music options.<sup>17</sup>

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<sup>16</sup> See the Examining Attorney's January 24, 2014 Office Action at \*2 (the "Second Office Action").

<sup>17</sup> See Apple's Second Response at \*6.

In response, the Examining Attorney dismisses the complexity of the instructions and information provided in the IPOD Quick Start Guide by qualifying them as “of value only upon *introductory use of* [Apple’s] digital media players”<sup>18</sup> (emphasis added). The Examiner cites to no authority mandating that the value of information in printed publication specimens need meet any kind of standard because it simply does not exist. Nonetheless, the IPOD Quick Start Guide is of analogous complexity to many of the third party manuals that Apple has submitted as examples of specimens accepted by the PTO.<sup>19</sup>

Next, the Examiner attempts to rely on length as the distinguishing factor between the IPOD Quick Start Guide and third-party analogous publications deemed acceptable by the PTO. The Examiner notes that three of the third party manuals submitted by Apple contain 400, 135 and 45 pages and suggests that there is some unknown minimum page number threshold that must be traversed for a specimen to be considered a valid good in trade.<sup>20</sup> The Examiner’s additional test as to length is without merit. There is no basis in the Trademark Rules for such a conclusion and it prejudices manufacturers employing minimalist design, as Apple is well known for doing. Instead, the routine practice of the PTO is to accept specimens of consumer electronics companies—such as simple user guides offered with hardware and software—many of which are akin to Apple’s specimen in terms of utility, function, and length. Some of the specimens of manuals the PTO has accepted consist of just the front and back cover of a manual or a simple tri-fold brochure about a company’s electronic goods offered under the same mark.<sup>21</sup> Obviously, these previously accepted specimens are no more deserving of acceptance than Apple’s sufficiently informative Quick Start Guides.

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<sup>18</sup> See Final Office Action at \*3.

<sup>19</sup> See Apple’s Request for Reconsideration.

<sup>20</sup> See Final Office Action at \*3.

<sup>21</sup> See Apple’s Request for Reconsideration, Ex. 3.



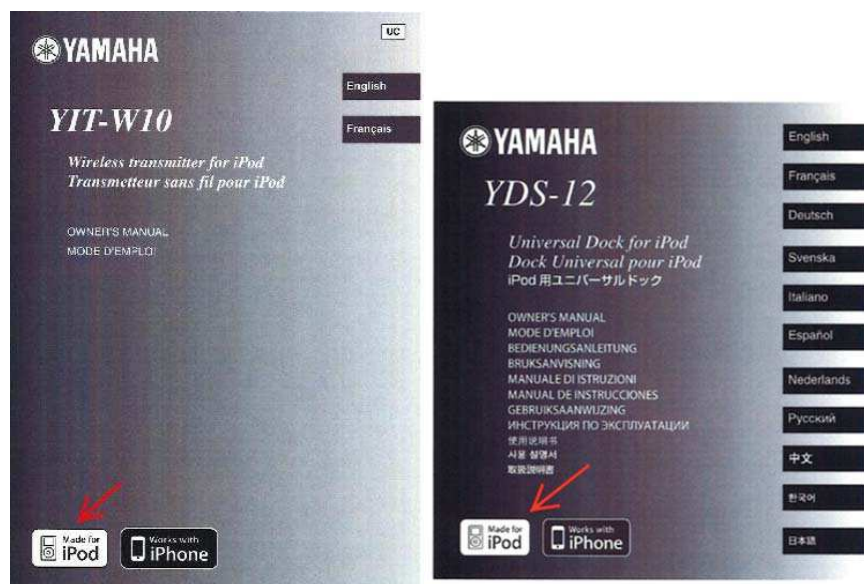
The Examining Attorney's distinctions for why certain user manuals and printed publications from technology companies are acceptable and Apple's IPOD Quick Start Guides are not acceptable are simply unsupported by the record and should be rejected by the Board.

## II. APPLE'S SUBSTITUTE SPECIMENS DESIGNATE SOURCE AND ARE VALID GOODS IN TRADE

Apple also provided as Substitute Specimens copies of several Sony and Yamaha product brochures that bear the IPOD mark in the composite Made for iPod Logo format shown below.<sup>22</sup>



The front covers of three such brochures bearing the Made for iPod Logo are reproduced below:



<sup>22</sup> See Apple's Second Response at \*11, Substitute Specimens.

**SONY**

4-165-352-11(1)

# Mini HI-FI Component System

**GB** Operating Instructions

MHC-EC909iP/EC709iP



© 2010 Sony Corporation

Printed in China

<http://www.sony.net/>

According to the Examining Attorney's novel "goods in trade" test, the Substitute Specimens should have met the Examining Attorney's requirements, as the IPOD mark is not being used for printed publications that are inextricably tied to Apple's iPod device and these third-party publications have independent value apart from Apple's iPod device.<sup>23</sup>

Nevertheless, the Examining Attorney erroneously rejected Apple's Substitute Specimens, in this case claiming that the third-party manuals are not goods in trade "because applicant's mark, as displayed on these manuals, are [sic] not used to provide source identifying information for the specific manuals. Instead, applicant's mark, 'IPOD', is displayed, and viewed by consumers, to indicate subject matter. Use of the mark on the Yamaha and Sony manuals references subject matter in the nature of compatibility for certain International Class 009 goods. 'IPOD' is not, however, displayed to designate the source of the printed materials."<sup>24</sup>

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<sup>23</sup> See *id.*

<sup>24</sup> See Final Office Action at \*3.

However, the use of the Made for iPod Logo is not a mere textual statement regarding compatibility of the respective devices. It is a licensed, controlled usage of Apple's IPOD mark, which is a clearly legitimate source identifying trademark usage. As submitted in its Request for Reconsideration, usage of the Made for iPod Logo is governed by Apple's MFi licensing program, pursuant to which third-party manufacturers such as Yamaha and Sony who wish to use the Made for iPod Logo must submit to Apple their devices and all associated documentation—including the Substitute Specimens—to ensure compliance with Apple's trademark guidelines and quality control measures.<sup>25</sup> Once approved, the manufacturers are authorized by Apple to use the Made for iPod Logo, with the license terms further providing for ongoing quality control by Apple and an acknowledgement that Apple owns the IPOD mark and that all licensed use of the IPOD mark inures to the exclusive benefit of Apple.<sup>26</sup>

Section 5 of the Trademark Act states “Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and *such use shall not affect the validity of such mark or of its registration*, provided such mark is not used in such manner as to deceive the public.”<sup>27</sup> Section 45 of the Act defines “related company” as “any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.”<sup>28</sup> It is well established that trademark licensors and licensees are valid related companies, and that use of a licensed mark by a licensee is a valid usage supporting registration by the licensor.

Thus, since the usage shown on the Substitute Specimens is licensed use controlled by Apple, the Substitute Specimens clearly do serve as source identifiers to consumers for the third-

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<sup>25</sup> See Apple's Request for Reconsideration, Exs. 4, 5.

<sup>26</sup> See *id.*

<sup>27</sup> 15 U.S.C. § 1055 (emphasis added).

<sup>28</sup> 15 U.S.C. § 1127.

party Sony and Yamaha publications, because consumers understand that the use of Apple's IPOD mark signifies that the devices and publications bearing such mark are officially licensed products, and that Apple has reviewed and approved such products, and therefore is functioning as a source for the brochures. As a result, the Substitute Specimens are valid "goods in trade" as they depict bona fide use of the IPOD mark in the ordinary course of trade on brochures of independent value pursuant to a license from Apple.

That the brochures bear more than one mark is of no import. *See, e.g., Weatherford/Lamb, Inc. v. C&J Energy Servs., Inc.*, 96 U.S.P.Q.2d 1834, 1840 (T.T.A.B. 2010) ("It is well settled that a party may use more than one mark to identify a product or service and thus may choose to use its housemark in conjunction with other marks."); *Textron Inc. v. Cardinal Eng'g Corp.*, 164 U.S.P.Q. 397, 399 (T.T.A.B. 1969) ("[T]here is no statutory limitation on the number of trademarks that one may use on or in connection with a particular product to indicate origin"). Accordingly, the Examining Attorney's rejection of the Substitute Specimens is erroneous and should be withdrawn.

### **III. CONCLUSION**

Apple submits that its arguments and evidence demonstrate that Apple's Original Specimen and Substitute Specimens both adequately demonstrate use of the IPOD mark with the goods recited in the Application. For the reasons set forth in this Brief, as well as in Apple's previously submitted papers and evidence, Apple respectfully requests that the Board reverse the Examining Attorney's refusal and allow this application to proceed to registration.

Dated: May 15, 2015

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

This is to certify that this APPEAL BRIEF was filed electronically with the Trademark Trial and Appeal Board via transmission through ESTTA on May 15, 2015.

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